

REMARKS**INTRODUCTION:**

In view of the above, claim 1 has been amended. No new matter is being submitted and entry and consideration is respectfully considered.

Claims 1-7 are pending and under consideration.

REJECTION UNDER 35 USC §103:

Claims 1-7 stand rejected under 35 USC §103(a) as being unpatentable over Satoh et al., U.S. Patent No. 5,038,659, and Tanimoto, U.S. Patent No. 4,450,743. This rejection is respectfully traversed.

The outstanding Office Action again sets forth a rejection of independent claims 1 and 6, based on a combination of Satoh et al and Tanimoto. The Office Action would appear to be primarily relying on Satoh et al. to disclose a majority of the claimed invention, including inherently, note code tables. The Office Action would further appear to be utilizing Tanimoto to disclose "note code tables that correspond to the input data...wherein input data and note codes also correspond to musical staff notation."

In applicant's previous response filed December 13, 2001, applicant had pointed out that Satoh et al. would not need a conversion table of Tanimoto, and thus teaches away from such a combination, and that there is no motivation for combining the same.

In response, the Office Action recites, beginning on page 3 of the Office Action, "[t]he applicant argues that the references do not suggest any reason or motivation to be combined. The applicant argues that Satoh et al. do not provide note conversion. However, Satoh et al. do provide input conversion and musical score display. Tanimoto provides note conversion and is relied upon for that reason. In combination, the references provide the teachings as claimed by the applicant."

Thus, the Office Action again asserts previous arguments that because a combination of Satoh et al. and Tanimoto disclose the presently claimed invention, it would have been obvious to modify Satoh et al. accordingly. However, the rejection is required to indicate why Satoh et al. would need or desire (i.e., be motivated) to include the identified features of

Tanimoto. The Office Action would appear to only recite features the two references have in common, without setting forth any motivation for combining the same.

As set forth in our previous remarks, Satoh et al. sets forth a musical score forming apparatus having a piano keyboard for entering notes and a function keyboard for entering words or numbers. The words are positioned above each line of the score to correspond to the applicable note combinations, and the numbers are utilized to determine a note's duration. Based on a note entered in the piano keyboard, and its duration entered on the function keyboard, a corresponding note is placed on a staff in a musical score. See col. 5, line 37, through col. 6, line 24. A CPU also determines inter-note distances before the notes are placed on the staff.

Satoh et al. also allows a user to enter word data, which is placed above a corresponding note in a staff, with a CPU receiving the inputted word and determining its proper placement. See col. 9, lines 8-25, and col. 10, line 27, through col. 11, line 36. As illustrated in FIG. 17, characters of the entered words, which may be entered as Roman characters, can be easily converted to Japanese characters.

Satoh et al. does not use any tables for note determination.

In Satoh et al., the note is entered through a piano keyboard, without the need for any tables. The outstanding Office Action fails to provide any suggestion or motivation why one or ordinary skill would have modified Satoh et al. to not use a piano keyboard, but rather, utilize the keypad of Tanimoto. The Office Action merely recites that it would have been obvious for such a modification "because Tanimoto provides a clear correlation of input data with stored table data including note codes to produce output data, wherein Satoh et al. provide correlation of input data with output data, only failing to show a clear correlation with note codes." But, Satoh et al. does not utilize any tables for a note determination. The portion of Satoh et al. that the Office Action has pointed to, col. 9, for showing the inherentness of a note code table in Satoh, is unrelated to note determination, but rather to converting entered song lyrics from Roman characters to Japanese, or Japanese to Roman.

Thus, there is **no need or suggestion to modify Satoh et al.** to utilize the note code tables of Tanimoto. That being the case, it would not have been obvious to combine the note code tables of Tanimoto with Satoh et al., as suggested in the Office Action. "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600.

The Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art..."[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). In addition, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Id. at 1783-84.

Further, "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine at 1600.

Since the Office Action has failed to provide a clear indication as to why one skilled in the art would have been motivated to combine Satoh et al. and Tanimoto, the outstanding rejection based on the same are improper. Therefore, it is both respectfully requested that this After Final Amendment be entered and considered, and it is respectfully submitted that the pending claims are in proper condition for allowance.

In addition, it is noted that independent claim 1 now specifically details that the claimed keyboard is a computer keyboard, which is different from the keyboard utilized in Satoh et al. or Tanimoto.

Therefore, in view of at least the above, it is respectfully requested that this rejection of claims 1-7 be withdrawn and claims 1-7 allowed.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

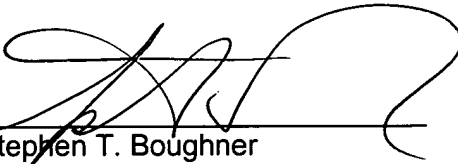
Respectfully submitted,

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8/26/02

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MARKED UP CLAIM AMENDMENTS

Please AMEND claim 1, as follows:

1. (THREE TIMES AMENDED) A data processor using a computer and a staff notation comprising:
 - a computer keyboard for input of character or symbol data into said data processor;
 - a note code table to correspond the inputted character or symbol data input into said data processor with character or symbol data and scales of music staff notation;
 - a note decoder to decode the inputted character or symbol data to corresponded to scale code data using said note code table;
 - a note code storage device to store output data from said note decoder in order as music staff notation data; and
 - an outputting means for outputting the music staff notation data from the note code storage device.